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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,564	07/20/2001	Michael C. Pelletier	SOM920010001US1	4357
23334	7590	04/29/2004	EXAMINER	
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/909,564

**Applicant(s)**

PELLETIER, MICHAEL C.

**Examiner**

Firmin Backer

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ML

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

This is in response to an amendment file on March 8<sup>th</sup>, 2004 for letter for patent filed on July 20<sup>th</sup>, 2001 in which claims 1-17 were presented for examination. In the amendment, claims 1-17 have been amended, no claim has been canceled, and no claim has been added. Claims 1-17 remain pending in the letter.

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart, III et al (U.S. PG Pub no. 2001/0037465) in view of McGuire et al (US PG Pub No. 2003/0023489).
4. As per claims 1, Hart III et al teach a computer implemented method to target advertisement to be sent along with encrypted digital content (*see abstract, paragraphs 0048, 0052*), the method comprising accepting an end user request from an end user for delivery of an encrypted digital content (*see paragraphs 0009, 0010*) determining using verification system

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during payment clearing, a payment clearing address (*determining customer information including address*) of the end user device based upon the payment account (*see paragraphs 0051-0053*). Hart III et al fail to teach an inventive concept of associating one or more pieces of advertisement with the content if the payment clearing address is in a predetermined geographic region. However, McGuire et al teach an inventive concept of associating one or more pieces of advertisement with the content if the payment clearing address is in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hart III et al's inventive concept to include McGuire et al's concept associating one or more pieces of advertisement with the content if the payment clearing address is in a predetermined geographic region because this would have provided a method/system to providing a targeted on-line advertisement to a user accessing a content provider node of the system specify each user who is entitled to the advertisement.

5. As per claims 2, Hart III et al teach a method wherein the step of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the address verification system returns an address in a predetermined geographic region and one or more usage conditions for the encrypted digital content authorizes the advertisement to be associated with the geographical region of the end user device requesting the encrypted digital content (*see paragraphs 0051-0053*).

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6. As per claims 3, Hart III et al teach a method further comprising determining an IP address of the end user device requesting delivery of the encrypted digital content, and wherein the step of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the address verification system returns an address in a predetermined geographic region or if the IP address of the end user device is in a predetermined geographic region (*see paragraphs 0051-0053*).

7. As per claims 4, Hart III et al teach a method further comprising determining an IP address of the end user device requesting delivery of the encrypted digital content, and wherein the step of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the address verification system returns an address in a predetermined geographic region and if the IP address of the end user device is in a predetermined geographic region (*see paragraphs 0047, 0049, 0048*).

8. As per claims 5, McGuire et al teach a method wherein determining an IP address of the end user device includes at least one of the following sub-steps: querying one or more IP addresses in IP databases provided by third parties; checking one or more country codes found in the trace routes to the IP address being determined; and using preassigned country allocations for class C IP addresses (*see paragraphs 0047, 0049, 0052*).

9. As per claims 6, McGuier et al teach a method wherein determining an IP address of the end user device includes computing a confidence for the IP address comprising the sub-steps of:

querying the IP address; and checking one or more country codes found in the trace routes; wherein after the confidence of is computed, the confidence is determined against other IP addresses returned for the geographic region being determined (*see paragraphs 0047, 0049, 136-139*).

10. As per claims 7, 13 and 17, Hart III et al teach a computer implemented method of content authoring site for advertisement to be sent along with content (*see abstract, paragraphs 0048, 0052*)), the method comprising accepting an end user request from an end user for delivery of an encrypted digital content (*see paragraphs 0009, 0010*) determining using verification system during payment clearing, a payment clearing address (*determining customer information including address*) of the end user device based upon the payment account (*see paragraphs 0051-0053*). Hart III, et al fail to teach receiving at a processor a geographic region for presenting advertisement associated with content setting on or more conditions for the advertisement associated with the digital content, wherein the conditions are selected from a group of conditions consisting of a time period when the advertisement is presented the number of times the advertisement is presented, whether the printing of coupons and other offers is permitted, and whether the sending of advertisement from the end user device receiving the advertisement to another end user device is permitted. However, McGuire teach receiving at a processor a geographic region for presenting advertisement associated with content (*see fig 24, paragraphs 0051-0053*) setting on or more conditions for the advertisement associated with the digital content, wherein the conditions are selected from a group of conditions consisting of a time period when the advertisement is presented (*see fig 24, paragraphs 0051-0053*), the number

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of times the advertisement is presented, whether the printing of coupons and other offers is permitted, and whether the sending of advertisement from the end user device receiving the advertisement to another end user device is permitted (*see paragraphs 0047, 0049, 136-139*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hart III et al's inventive concept to include McGuire et al's concept teach receiving at a processor a geographic region for presenting advertisement associated with content setting on or more conditions for the advertisement associated with the digital content, wherein the conditions are selected from a group of conditions consisting of a time period when the advertisement is presented the number of times the advertisement is presented, whether the printing of coupons and other offers is permitted, and whether the sending of advertisement from the end user device receiving the advertisement to another end user device is permitted because this would have provided a method/system to providing a targeted on-line advertisement to a user accessing a content provider node of the system specify each user who is entitled to the advertisement.

11. Claims 8-12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al (US PG Pub No. 2003/0023489) in view of Hart, III et al (U.S. PG Pub no. 20010037465).

12. As per claims 8, 9 and 14, McGuire et al teach a method of an online store to target advertisement to be sent along with content (*see abstract, figs 1-5*), the method comprising the steps of: determining an IP address of an end user device requesting delivery of the content by

performing querying one or more IP addresses in IP databases provided by third parties (*see abstract, figs 1-5*); checking one or more country codes found in the trace routes to the IP address being determined, (*see paragraphs 0047, 0049, 136-139*) and using preassigned country allocations for class C IP addresses; and associating one or more pieces of advertisement if the geographical location of the end user device is in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*). McGuire et al fail to teach an inventive concept wherein a user requests the delivery of encrypted digital content. However, Hart III, et al teach an inventive concept wherein a user requests the delivery of encrypted digital content (*see (see abstract, paragraphs 0048, 0052)*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McGuire et al's inventive concept to include Hart III et al's concept wherein a user request the delivery of encrypted digital content because this would have provided a method/system to specify each user who is entitled to the service the provider intends to provide, and prevent eavesdroppers from connecting themselves to the information transmission path and stealing service information (information steal protection).

13. As per claims 10, McGuire et al teach a method wherein the programming instruction of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the IP address of the end user device returns an address in a predetermined geographic region and one or more usage conditions for the encrypted digital content authorizes the advertisement to be associated with the geographical region of the end user device requesting the encrypted digital content (*see paragraphs 0047, 0049, 136-139*).



14. As per claims 11, Hart III et al teach a method wherein further comprising the instruction of: determining a credit card clearing address of the end user using an address verification system, wherein an end user sends a request via the end user device for the delivery of encrypted digital content; and wherein the programming instruction of determining an IP address of the end user device requesting delivery of the encrypted digital content, and wherein the programming instruction of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the IP address is in a predetermined geographic region or if the address verification system returns an the IP address of the end user device is in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*)

15. As per claims 12, Hart III et al teach a method wherein. The computer readable medium of claim 9, further comprising the instruction of: determining a credit card clearing address of the end user using an address verification system, wherein an end user sends a request via the end user device for the delivery of encrypted digital content; and wherein the programming instruction of determining an IP address of the end user device requesting delivery of the encrypted digital content, and wherein the programming instruction of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the IP address is in a predetermined geographic region and if the address verification system returns an the IP address of the end user device is in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*).

16. As per claims 15, McGuire et al teach an information processing system includes associating advertisement with the encrypted digital content if the IP address of the end user device returns an address in a predetermined geographic region and one or more usage conditions for the encrypted digital content authorizes the advertisement to be associated with the geographical region of the end user device requesting the encrypted digital content (*see paragraphs 0047, 0049, 136-139*).

17. As per claims 16, McGuire et al teach an information processing system includes associating advertisement with the encrypted digital content if the IP address of the end user device returns an address in a predetermined geographic region and one or more usage conditions for the encrypted digital content authorizes the advertisement to be associated with the geographical region of the end user device requesting the encrypted digital content (*see paragraphs 0047, 0049, 136-139*).

### ***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

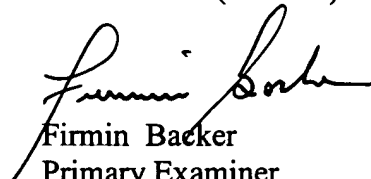
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Firmin Backer  
Primary Examiner  
Art Unit 3621

April 27, 2004